

REMARKS

In the application claims 1-39 remain pending. No claims presently stand allowed. The reconsideration of the rejection of the claims is, however, respectfully requested.

In the Restriction Requirement of August 5, 2004 the Examiner has asserted that the claims were directed to two distinct inventions. Applicant responded by way of its Amendment and Communication of October 5, 2005. Applicant notes that the Examiner has now withdrawn the prior Restriction Requirement.

Claims 1 – 39 have been rejected under 35 U.S.C. 102(e) as being anticipated by Niwa, U.S. PG Pub. No. 2002/0188574, and specifically has based rejection of each and every pending claim on the disclosure purportedly set forth in paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035 of Niwa.

Applicant respectfully traverses the Examiner's substantive bases for rejection of the claims.

Niwa describes a method for authorizing a commercial transaction, such as the purchase of goods or services wherein the provider requests that the customer provide authorization by activating a fingerprint identification device toward generating an authorization code with the objective of preventing fraudulent payments being made through the detection of a specific biometric characteristic of the consumer, specifically the consumer's fingerprint. As described therein, the consumer is provided with a fingerprint identification device which detects a user's fingerprint and confirms whether the user is indeed authorized by generating an authorization code which is in turn

transmitted to the provider of goods of services.

As disclosed in paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035 of Niwa, in the context of the purchase of goods or services, the consumer selects the particular goods or services to be purchased. The consumer is then prompted to provide authentication by activating the fingerprint identification device. The merchant/vendor passes the authentication code, together with other data such as bank identification number, customer account number and purchase amount, to a managing entity, such as a credit card processing facility, who confirms the authentication and issues a payment authentication to the merchant/vendor. The merchant/vendor, receiving confirmation that payment will be made, proceeds to complete the transaction by for example shipping the goods to the consumer.

Applicant submits that the pending claims 1 – 39 patentably distinguishes over the prior art cited by the Examiner, and that all of the Examiner's bases for rejection of claims 1 - 39 should be deemed overcome. Reconsideration and withdrawal of the rejections of claims 1 - 39, and allowance thereof are respectfully solicited.

The Examiner has rejected independent claim 1 stating that Niwa purportedly teaches a method of electronically executing a commercial transaction between a customer and a vendor, the method comprising transmitting electronically a transaction code from the customer to an electronic order processing system associated with the vendor; receiving the transaction code by the order processing system associated with the vendor; identifying the user based upon the contents of the transaction code; authenticating the transaction code; identifying a commercial transaction associated

with the transaction code; and executing the identified commercial transaction (see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035). Upon a detailed review of each of the cited paragraphs of the Niwa reference and the document as a whole Applicant respectfully submits that Niwa fails to disclose, teach or suggest the elements of claim 1 and in particular lacks any disclosure, teaching or suggestion of the use of a transaction code that identifies the actual commercial transaction sought to be consummated by the consumer, nor any disclosure, teaching or suggestion of executing an identified commercial transaction based upon the transaction code.

The method of claim 1 expressly requires the steps of transmitting a transaction code from the customer to an electronic order processing system associated with the vendor, identifying the user based upon the content of the transaction code, and identifying the specific commercial transaction sought to be consummated by reference to the transaction code (i.e. an identification of or reference to the actual goods or services sought to be purchased – as distinguished from the payment amount) and finally executing the commercial transaction.

The system of Niwa is in fact merely an authentication system that is designed to prevent an unauthorized individual from attempting to authorize payment for a commercial transaction or gaining unauthorized access to a safe deposit box, but does not permit the automatic placement of an order for goods or services or otherwise execute a pre-determined commercial transaction. Niwa expressly contemplates that the consumer configure the transaction each time a purchase is made by identifying the particular goods or services to be purchased each time a purchase is to be made – and

does not disclose the ability to execute a predetermined transaction or repeat a prior transaction. In short, Niwa simply discloses the use of a fingerprint identification device as a replacement for a user PIN (personal identification number) used to secure use of payment methods such as debit cards and simply fails to disclose or suggest the transaction code as disclosed in the present application and recited in claim 1.

Inasmuch as dependent claims 2 – 13 merely serve to further define the subject matter of claim 1, which itself should be deemed allowable, claims 2 – 13 also should be deemed to patentably distinguish over the cited prior art. Reconsideration and withdrawal of the rejections of claims 2 – 13 and allowance thereof, are respectfully solicited.

As to independent claim 14, the Examiner states that Niwa purportedly teaches a method of electronically executing a commercial transaction between a customer and a vendor, the method comprising the steps of: dialing a transaction code comprised of a telephone dial sequence onto a telephone network directed to an order processing system associated with the vendor; receiving a telephone call by the order processing system as a result of the dialing of the transaction code; detecting caller identification information received by the order processing system from the telephone network in conjunction with the telephone call; detecting at least a portion of the transaction code dial sequence by the order processing system associated with the vendor; identifying the user based upon the caller identification information received by the order processing system; identifying a commercial transaction associated with the transaction code; and executing the identified commercial transaction.

Upon review of each of the cited paragraphs of the Niwa reference Applicant respectfully submits that Niwa simply fails to disclose, teach or suggest detecting caller identification information received by an order processing system from a telephone network, identifying a user based upon the caller identification information received by the order processing system; identifying a commercial transaction associated with the transaction code; or executing an identified commercial transaction.

Inasmuch as dependent claims 15 – 17 merely serve to further define the subject matter of claim 14, which itself should be deemed allowable, claims 15 – 17 also should be deemed to patentably distinguish over the cited prior art. Reconsideration and withdrawal of the rejections of claims 15 – 17 and allowance thereof, are respectfully solicited.

As to independent claim 18, the Examiner states that Niwa purportedly teaches a method for configuring an electronic user device for the automated execution of a commercial transaction between a customer and a vendor, the method comprising generating a transaction code comprised of encoded information associated with the commercial transaction; conveying the transaction code to the user device electronically; storing the transaction code within the user device; transmitting the transaction code by the user device to initiate the execution of the commercial transaction with which the transaction code is associated.

Upon review of each of the cited paragraphs of the Niwa reference Applicant respectfully submits that Niwa fails to disclose, teach or suggest configuring a user's device toward the automatic execution of a commercial transaction. Niwa simply does

not contemplate conveying a transaction code as disclosed in the present application to a user device to in turn permit the user to use the device to execute a commercial transaction. Indeed, no mention is made of a user device yet alone the process of configuring same by generating a transaction code or storing a transaction code in a device.

Inasmuch as dependent claims 19 – 24 merely serve to further define the subject matter of claim 18, which itself should be deemed allowable, claims 19 – 24 also should be deemed to patentably distinguish over the cited prior art. Reconsideration and withdrawal of the rejections of claims 19 – 24 and allowance thereof, are respectfully solicited.

As to independent claim 25, the Examiner states that Niwa purportedly teaches a method for the dissemination of information to a mobile electronic user device based upon the device location, for the facilitation of a commercial transaction between a customer and a vendor, the method comprising the steps of: identifying the location of the user device; determining that the location of the user device conforms to a predetermined location criterion for receipt of a message; conveying the message to the user device electronically.

Upon review of each of the cited paragraphs of the Niwa reference Applicant respectfully submits that Niwa fails to disclose, teach or suggest any use or reference to the consumer's location, and specifically the steps of identifying the location of the user's electronic device, determining the user's location or electronically conveying a message to the user's device.

Inasmuch as dependent claims 26 - 36 merely serve to further define the subject matter of claim 25, which itself should be deemed allowable, claims 26 – 36 also should be deemed to patentably distinguish over the cited prior art. Reconsideration and withdrawal of the rejections of claims 26 -36 and allowance thereof, are respectfully solicited.

As to independent claim 37, the Examiner states that Niwa purportedly teaches a method for the dissemination of information to a mobile electronic user device based upon the device location, for the facilitation of a commercial transaction between a customer and a vendor, the method comprising identifying the current location of the user device; identifying the direction and rate at which the user device is moving; determining that the location, direction of travel and rate of travel of the user device conform to one or more predetermined criterion for receipt of a message; conveying the message to the user device electronically.

Upon review of each of the cited paragraphs of the Niwa reference Applicant respectfully submits that Niwa fails to disclose, teach or suggest identifying the direction and rate at which the user device is moving for any purpose within the scope of the Niwa system.

Inasmuch as dependent claims 38 - 39 merely serve to further define the subject matter of claim 37, which itself should be deemed allowable, claims 38 -39 also should be deemed to patentably distinguish over the cited prior art. Reconsideration and withdrawal of the rejections of claims 38 - 39 and allowance thereof, are respectfully solicited.

CONCLUSION


It is respectfully submitted that the cited reference fails to disclose, teach, or suggest each and every element set forth in the pending claims. For at least this reason it is submitted that the application is in good and proper form for allowance. Such action of the part of the Examiner is respectfully requested. Should it be determined, however, that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

The Commissioner is authorized to charge any fee deficiency or credit overpayment to deposit account 50-2428 in the name of Greenberg Traurig.

Respectfully submitted,

GREENBERG TRAURIG, LLP

Dated: June 22, 2005



Howard E. Silverman
One of Attorneys for Applicant

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail postage pre-paid under 37 C.F.R. § 1.8 in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 22, 2005.